

Remarks

Applicant respectfully requests consideration of the instant application in view of the following remarks.

Priority Date

The Examiner has stated that "[t]his application claimed the priority of 12/19/200". Applicant respectfully submits that this application claims a priority of 12/18/200, as stated on page 1 at line 4 of the application, and as evidenced by the Declaration and the Official Filing Receipt for U.S. Provisional Application No. **60/256,781**, copies of which were provided in the Appendix of the previous reply filed on 24 January 2006. The instant application claims the benefit of U.S. Provisional Application No. **60/256,781** filed on December 18, 2000.

Claim Status

Claims **1-43** are pending in the application.

The Examiner has stated under the heading "***Claim Rejections – 35 USC § 101***" that the claimed invention is directed to non-statutory subject matter, lacks patentable utility, and is inoperative and therefore lacks utility. However, the Examiner has not cited any particular claims that are being rejected under **35 U.S.C. § 101**.

Claims **1-43** stand rejected under **35 U.S.C. § 112**, first paragraph, as based on a disclosure which is not enabling, because the Examiner considers "The client computer system" and "client1 provides passkey to client 2 via separate communication link" as being critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure.

Claims **1-43** stand rejected under **35 U.S.C. § 112**, first paragraph, as based on a disclosure which is not enabling, because the Examiner considers "client1 provides passkey to client2 via separate communication link," step 218, FIG. 2, as being critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure.

Claims **1-43** stand rejected under **35 U.S.C. § 102(e)** as being anticipated by U.S. Patent No. **6,597,770** to Walker et al., or in the alternative, under **35 U.S.C. § 103(a)** as being obvious over Walker et al.

Claim Rejections Under 35 U.S.C. § 101

The Examiner has stated under the heading “***Claim Rejections – 35 USC § 101***” that the claimed invention is directed to non-statutory subject matter, lacks patentable utility, and is inoperative and therefore lacks utility. However, the Examiner has not cited any particular claims that are being rejected under **35 U.S.C. § 101**.

Item A

The Examiner has stated that “the claimed invention is directed to non-statutory subject matter. (i.e.: “providing for” does not establish a concrete, tangible result[s], that the Examiner cannot perform an undue experiment where and how the server provides the passcode to the first client to perform the reading data on a removable memory and How the first and second client enable the communication and what device provides the communication between the removable memory and client 1, client 2.”

First, to clarify, the claims do not state that the “server provides the passcode to the first client to perform the reading data on a removable memory”. Instead, the first client obtains the passcode information (e.g. from the first user), authenticates this passcode information, and then receives a first passkey from the server if the passcode information is authentic for the portable memory element.

Second, if the Examiner is asserting that the language “providing for” in a claim causes that claim to be drawn to non-statutory subject matter, then Applicant respectfully refers the Examiner to the following issued U.S. patents which incorporate such language in one or more claims: **6,529,811; 6,756,764; 6,901,810; 6,988,367; 7,028,191 and 7,057,503**.

Finally, the “providing for” language simply establishes to point of view of the claim to be directed to a party the provides the system, software or other means for carrying out the operations of the claimed method.

Items B and C

The Examiner appears to assert that a claimed invention drawn to “a client computer system” inherently lacks patentable utility, and is therefore inoperative because of this lack of utility. Computer systems are widely known in this day and age as having utility.

Furthermore, Applicant respectfully refers the Examiner to the following issued U.S. patents in which one or more claims are drawn to a “client computer system”: **6,189,108**; **6,317,826** and **6,959,331**.

Applicant respectfully requests reconsideration and withdrawal of these rejections, to whatever claims they may apply.

Claim Rejections Under 35 U.S.C. § 112

Claims **1-43** stand rejected under **35 U.S.C. § 112**, first paragraph, as based on a disclosure which is not enabling, because the Examiner considers “The client computer system” and “client1 provides passkey to client 2 via separate communication link” as being critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure.

Claims **1-43** stand rejected under **35 U.S.C. § 112**, first paragraph, as based on a disclosure which is not enabling, because the Examiner considers “client1 provides passkey to client2 via separate communication link,” step 218, FIG. 2, as being critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure.

Applicant respectfully submits that the Examiner has not established a prima facie basis for making either of these rejections. The Examiner has not satisfied the all of the requirements of **MPEP § 706.03(c)**, paragraph 7.33.01. More particularly, the Examiner has not given “the rationale for considering the omitted subject matter to be critical or essential” (Examiner Note 3), and has not cited “the statement, argument, data, drawing or other evidence which demonstrates that a particular feature was considered essential by the applicant, is not reflected in the claims with are rejected.” (Examiner Note 4)

Furthermore, Applicant notes that either the first client or the at least one second client – either of which may be implemented with an associated computer system -- is referenced in claims **1, 2, 7-13, 16, 17, 19-41**, i.e. which includes every independent claim.

Applicant respectfully requests reconsideration and withdrawal of these rejections in view of the argument hereinabove.

Claim Rejections Under 35 U.S.C. §§ 102(e) or 103(a)

Claims 1-43 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,597,770 to Walker et al., or in the alternative, under 35 U.S.C. § 103(a) as being obvious over Walker et al.

Applicant respectfully traverses, and respectfully submits that Walker et al. is not a proper reference under 35 U.S.C. 35 U.S.C. §§ 102(e) or 103(a) because, as explained more fully hereinbelow, it fails to disclose all of the elements and limitations of any claims of the instant invention.

Regarding claims 1, 20, 23, 33 and 40, Applicant respectfully submits that Walker et al. neither discloses nor suggests all of the elements and limitations of claims 1, 20, 23, 33 and 40, and therefore is not a proper reference under 35 U.S.C. §§ 102(e) or 103(a). Furthermore, Applicant respectfully submits that the Examiner has not properly interpreted Walker et al. in view of the instant application, but instead, has used impermissible hindsight reasoning to reject claims 1, 20, 23, 33 and 40. Applicant respectfully submits that, as best understood, Walker et al. does not disclose or suggest the following elements of claims 1, 20, 23, 33 and 40:

Passcode necessary to access data from portable memory element (claims 1, 20, 23, 33 and 40): Applicant respectfully submits that Walker et al. does not disclose or suggest a passcode associated with the portable memory element. The Examiner has suggested that the user identifier on col. 7, lines 42-52 of Walker et al. corresponds to this passcode, however, as best understood, this user identifier is not necessary to access data from the portable memory element (credit card, as suggested by the Examiner), but instead is information stored on the credit card and in a user database 400 (FIG. 5) on the server (30) (FIG. 2) of Walker et al.

Authentication of passcode information (claims 1, 20, 23, 33 and 40): Applicant respectfully submits that Walker et al. does not disclose or suggest the authentication of passcode information provided by a user and associated with the portable memory element. As best understood, col. 7, lines 53-62 of Walker et al., referred to by the Examiner, pertains to the authorization of a financial

transaction, and not to the authentication of a passcode associated with the portable memory element.

First passkey from server to client (claims 1, 20, 23, 33 and 40): Applicant respectfully submits that Walker et al. does not disclose or suggest a first passkey that is provided by the server to the first client. As best understood, col. 4, lines 1-10, referred to by the Examiner, pertains to the identifiers of the credit card (i.e. credit card number) and the card authorization terminal (“CAT”), which are not provided by the server to the first client, but which instead are provided by the first client to the server. Accordingly, Walker et al. does not disclose or suggest a passkey that is provided if the passcode information is authentic for the given portable memory element.

First passkey from first user associated with first client to second user associated with second client (claims 33 and 40): Applicant respectfully submits that Walker et al. does not disclose or suggest providing for a first user associated with the first client to provide a first passkey to at least one second user associated with at least one second client computer system. Instead, as best understood, in Walker et al., the server is adapted to contact a second user, and enable the second user to contact the first user, responsive to the initiation of a transaction by the first user without separate prior communication between the first and second users.

Second passkey from second client to server (claims 1 and 20): Applicant respectfully submits that Walker et al. does not disclose or suggest providing for a server to receive a second passkey or second signal from a second client. As best understood, col. 13, lines 39-42, referred to by the Examiner, refers to the association of a second user with the credit card being used by the first user, but does not disclose or suggest the receipt of a second passkey from the second user. Instead, this association would appear to result from information already stored in a database on the server.

Communication of information with second client (claims 1, 20, 23, 33, 40):

Applicant respectfully submits that Walker et al. does not disclose or suggest providing for a first client to communicate with a second client if a second passkey corresponds to a first passkey. Instead, as best understood, in Walker et al., the communication between the first and second users is provided for responsive to the credit card information stored in a database on the server, which is accessed responsive to the first user's initiation of a transaction with the credit card. The server does not provide a first passkey to the first user, the second user does not provide a second passkey (which if correct would correspond to the first passkey) to the server, the server does not determine if the second passkey corresponds to the first passkey, and the server does not provide for communication between the first and second clients responsive to this comparison.

Personal Identification Service server of a CORBAMED system (claim 20):

Applicant respectfully submits that Walker et al. does not disclose or suggest a CORBAMED system, and FIG. 2 of Walker et al. does not disclose or suggest such a system. There is no mention of CORBAMED anywhere in Walker et al.

Data input device for entering passcode information (claim 33):

Applicant respectfully submits that Walker et al. does not disclose or suggest the entry of passcode information, nor a data input device for entering passcode information. Instead, as best understood, the credit card provides all of the information necessary for the transaction to be conducted by the first user.

Portable memory element for storing passcode information (claim 40):

Applicant respectfully submits that Walker et al. does not disclose or suggest a portable memory element adapted to store passcode information, wherein the passcode information is used to verify whether the first user of the portable memory element will be permitted to access the information on the portable memory element. Instead, as best understood, the first user ("second person") of Walker et al. is able to initiate a transaction using the credit card as a result of mere

possession of the credit card, and the second user (e.g. “first person” / “account holder”) is then contacted telephonically responsive to the initiation of the transaction so as to separately authorize the transaction – without using either passcodes or passkeys in accordance with the present application. The credit card information stored on the credit card is the data of the portable memory element, not a passcode that controls access to that portable memory element.

Applicant respectfully submits that the Walker et al. neither discloses nor suggests the elements and limitations of claims **1, 20, 23, 33** and **40**. Because of this, Applicant respectfully submits that claims **1, 20, 23, 33** and **40** are distinguished from Walker et al., and that the rejections under **35 U.S.C. §§ 102(e) and 103(a)** of claims **1, 20, 23, 33** and **40** are not justified. Accordingly, Applicant respectfully requests reconsideration and allowance of claims **1, 20, 23, 33** and **40** in view of the above argument.

Claims **2-19** each depend upon claim **1**; claims **21** and **22** each depend upon claim **20**; claims **24-32** each depend upon claim **23**; claims **34-39** each depend upon claim **33**; and claims **41-43** each depend upon claim **40**. Accordingly, Applicant respectfully submits that if the above argument regarding the novelty of claims **1, 20, 23, 33** and **40** in view of Walker et al. is accepted, then claims **2-19, 21, 22, 24-32, 34-39** and **41-43** are also distinguished from Walker et al. because the addition of further limitations to an already novel and non-obvious claim does not negate novelty or non-obviousness. Applicant respectfully requests reconsideration and allowance of claims **2-19, 21, 22, 24-32, 34-39** and **41-43** in view of the above argument in respect of claims **1, 20, 23, 33** and **40**.

Furthermore, regarding claims 2 and 25, Applicant respectfully submits that Walker et al. does not disclose or suggest a method of providing for communications between a client and a server comprising providing for encrypting the transmitted signals and decrypting the received signals, wherein the client is adapted to communicate with the portable memory element. As best understood, col. 8, lines 33-39 of Walker et al., referred to by the Examiner, refers to a possible encoding of the credit card identifier of a credit card, but this refers to the information stored in the credit card, and not to the encryption and decryption of information communicated between the client and server. For example, Walker et al. does not disclose or suggest the

encryption of information of the credit card – whether originally encoded or not -- upon communication to the server, as would be provided by claims **2** and **25**. In other words, if the information were encoded on the credit card, Walker et al. does not disclose or suggest the communication of this information in anything other than plaintext.

Furthermore, regarding claims 4 and 27, Applicant respectfully submits that Walker et al. does not disclose or suggest medical information of a person who is capable of providing the passcode information necessary to access data from the portable memory element medical, but instead, as best understood, col. 11, lines 46-60 of Walker et al., referred to by the Examiner, would appear to disclose a “medical card” to be used in a transaction, e.g. seeking medical services, which would appear to refer to a prospective financial transaction. Walker et al. does not disclose or suggest anything further about the contents of such a “medical card”, as provided by claims **4** and **27**.

Furthermore, regarding claims 5, 28, 34 and 41, Applicant respectfully submits that the Walker et al. does not disclose or suggest passcode information comprising at least one fingerprint of a person associated with the portable memory element, or a fingerprint reader for reading this information. Nor, as described hereinabove, does Walker et al. disclose or suggest any passcode associated with the portable memory element. On col. 6 at lines 32-41, Walker et al. describes the user identifier as follows:

“Field 400 A stores a user identifier that is associated with and that uniquely identifies a credit card that is associated with a credit card account represented by a record in database 200. In this embodiment, the identifier stored in field 400 A is a sixteen digit credit card account number, such as the type commonly imprinted on a credit card. The user identifier need not be associated with nor uniquely identify a credit card that is associated with the credit card account. For example, the user identifier may be directly associated with the credit card account.” (emphasis added)

Accordingly, the “user identifier” of Walker et al. is described as being associated with the credit card or credit card account, and is not described as being associated with the user of the credit card. Indeed, the system of Walker et al. provides for a “first person” having an account to authorize a transaction between a “second person” and a third party, so that the credit card account is associated with the “first person”, not the “second person” who is actually using the card, and whose fingerprint the Examiner purports could be a “user identifier”. Applicant

respectfully submits that the Examiner has used improper hindsight reasoning in view of the teachings of the instant application to suggest that the “user identifier” of Walker et al. inherently also teaches a fingerprint of a person associated with the credit card.

Furthermore, regarding claims 6 and 29, Applicant respectfully submits that Walker et al. does not disclose or suggest passcode information necessary to access information on the portable memory element, wherein the passcode information comprises either alphanumeric information or biometric information provided by a person associated with the portable memory element. As best understood, col. 11, lines 46-60 of Walker et al., referred to by the Examiner, and particularly the Examiner’s reference to “health club card”, is silent about the nature of any passcode information necessary to access the card, nor is there any teaching of the provision for entering alphanumeric information or biometric information by a person using the portable memory element. The argument hereinabove in respect of claims **5, 28, 34** and **41** is incorporated herein by reference. As best understood, the mere possession of the credit card (as a token) by the “second user” would appear to be sufficient to initiate a transaction with a third party, wherein Walker et al. provides for authorization of the transaction by the “first person” who controls the credit card account.

Furthermore, regarding claim 7, Applicant respectfully submits that Walker et al. does not disclose or suggest a first client that is mobile. As best understood, FIG. 2 of Walker et al., referred to by the Examiner, illustrates a database on a server, and therefore does not pertain to the client. Furthermore, as best understood, Walker et al. does not disclose or suggest a first client that is anything but stationary. For example, the client illustrated in FIG. 1 (Merchant CAT 15) is not disclosed as capable of being mobile, and all of the transactions discussed on col. 11 at lines 47-60 pertain to fixed locations. Applicant respectfully submits that the Examiner has used improper hindsight reasoning in view of the teachings of the instant application to reject claim 7.

Furthermore, regarding claims 8, 21 and 30, Applicant respectfully submits that Walker et al. does not disclose or suggest providing for enabling the first client either to read information from, or to record information to, the portable memory device if the passcode information is authentic for the portable memory element. As best understood, col. 10, lines 37-

42 of Walker et al., referred to by the Examiner, refers to an authorization code in a database on the server, which appears to be related to the authorization of a financial transaction, and does not refer to a passcode that provides for reading information from, or recording information to, the portable memory device. the mere possession of the credit card (as a token) by the “second user” would appear to be sufficient to initiate a transaction with a third party, and Walker et al. neither discloses nor suggests a passcode being used to access information on the credit card. The authorization of a financial transaction using the credit card occurs after the credit card information has already been read from the credit card without using a passcode.

Furthermore, regarding claims 9 and 31, Applicant respectfully submits that Walker et al. does not disclose or suggest information recorded by the first client on the portable memory element per claim 8 as comprising either voice information, data from a medical instrument, data from a keyboard or keypad, or handwritten data. As best understood, the reference to the “interactive voice response unit” on col. 4, lines 30-43 of Walker et al., referred to by the Examiner, does not pertain to information being recorded on the portable memory unit, but instead is used to provide for an interface between the server and the “account holder”, i.e. the “first user” who provides for authorizing the transaction between the “second user” and the third party. Furthermore, the reference to “medical card” on col. 11, lines 46-60 of Walker et al., referred to by the Examiner, does not disclose or suggest any particular type of information that would be stored on the medical card by the first client, or even the prospect of storing any information by a first client. Yet further, the reference to “multimedia” on col. 5, lines 1-17 of Walker et al., referred to by the Examiner, pertains to memory 110 of the server, and does not pertain to the type of information recorded by a first client on the portable memory unit (e.g. credit card referred to by the Examiner).

Furthermore, regarding claims 10 and 32, Applicant respectfully submits that Walker et al. does not disclose or suggest the identification of a level of authority of a client, or controlling access to the data responsive to the level of authority. As best understood, col. 7, lines 53-62 of Walker et al., referred to by the Examiner, refers to an authorization code which is stored in a database on the server, and which pertains to the authorization of a financial transaction, but which does not provide for controlling access to the data on the portable memory

element in accordance with claims **10** and **32**. Furthermore, the authorization code does not appear to be related to a level of authority.

Furthermore, regarding claims 11 and 24, Applicant respectfully submits that Walker et al. does not disclose or suggest providing for a first user associated with the first client to provide the first passkey to at least one second user associated with at least one second client. As best understood, on col. 4, lines 1-10 of Walker et al., referred to by the Examiner, the “ID” that identifies a credit card is simply the credit card number, and not a passkey provided to the first client/first user by the server. Furthermore, in Walker et al., the “second person” who is using the credit card, does not communicate this “ID” to the “first person” who has the credit card account, and the “first person” does not then communicate this “ID” back to the server. Instead, as best understood, the “second person” uses the credit card to initiate a financial transaction with a third party, and the Merchant CAT (“first client”) communicates with the server, which then contacts the “first person” by telephone in order to obtain authorization for the financial transaction being conducted using the credit card of the “first person”.

Furthermore, regarding claim 12, Applicant respectfully submits that Walker et al. does not disclose or suggest providing for encrypting signals sent to the second client and decrypting those signals received by the second client. As best understood, col. 8, lines 33-39 of Walker et al., referred to by the Examiner, refers to the coding of information on the credit card, but does not disclose or suggest the encryption of signals that are communicated between the second client and the server. For example, in Walker et al., the server contacts the “first person” / “account holder” by phone, and there is no disclosure or suggestion that this communication between the server and the “first person” (“second client”) is encrypted or decrypted by either the server or the second client by which communication is performed with the “first person”.

Furthermore, regarding claims 13 and 22, Applicant respectfully submits that Walker et al. does not disclose or suggest the operation of providing for enabling at least one second client either to read information from, or to record information to, the portable memory device if a second passkey corresponds to a first passkey. As best understood, the user database illustrated in FIG. 5 and described on col. 6, lines 20-30 of Walker et al., referred to by the Examiner, enables an “account holder” (“first person”) to communicate with a user (“second

person”) to determine at least a portion of the circumstances surrounding a transaction that is being executed by the user. As best understood, there is no disclosure or suggestion here of the second client (“account holder”/“first person”) either reading information from, or recording information to, the portable memory device (“credit card”), nor is there any disclosure or suggestion of enablement responsive to whether a second passkey (provided by the second client) corresponds to a first passkey (provided to the first client), nor is there any disclosure or suggestion of a passkey for enabling access to information on the portable memory element.

Furthermore, regarding claims 14 and 15, Applicant respectfully submits that Walker et al. does not disclose or suggest a CORBAMED system, let alone a CORBAMED system comprising a Terminology Query Service server, a Clinical Observation Access Service server, and a Resource Access Decision server. As best understood, FIG. 2 of Walker et al., referred to by the Examiner, illustrates a plurality of databases on a server 30, all of which are relevant to a financial transaction using a credit card, but none of which refer to either a CORBAMED system. Furthermore, there is no suggestion that the server 30 is either a Terminology Query Service server, a Clinical Observation Access Service server, or a Resource Access Decision server. Furthermore, Applicant respectfully submits that neither a CORBAMED system, nor the associated servers thereof, are inherent features of a telecommunications network.

Furthermore, regarding claim 17, Applicant respectfully submits that Walker et al. does not disclose or suggest either a CORBAMED system, or a method of communicating the at least one trait to the CORBAMED system and communicating data from the CORBAMED system corresponding to the at least one trait to at least one of the first client and the at least one second client. As best understood, notwithstanding that col. 4, lines 53-59 of Walker et al., referred to by the Examiner, discloses that the server maintains data related to the “account holder”, as best understood, Walker et al. does not disclose or suggest that the server communicates any of this data to either the first client (“second user”) or the second client (“first user” / “account holder”). Furthermore, Walker et al. does not even disclose or suggest the use of a portable memory element in the context of a CORBAMED system.

Furthermore, regarding claim 18, Applicant respectfully submits that Walker et al. does not disclose or suggest either a CORBAMED system, or at least one trait defined in

accordance with a Health Level 7 (HL7) specification. As best understood, regarding the “health club card” listed on col. 11, lines 46-60 of Walker et al., referred to by the Examiner, there is no reference to any of the information that would be stored on such a card, nor is there any reference to a trait defined in accordance with a Health Level 7 (HL7) specification associated with a CORBAMED system. It would appear that the “health club card” referred to by the examiner is for controlling access to a health club, rather than being part of a medical information system.

Furthermore, regarding claims 38 and 42, Applicant respectfully submits that Walker et al. does not disclose or suggest the operation of providing for storing information on the portable memory element. As best understood, Walker et al. does not disclose or suggest the operation of storing information on the portable memory element, but instead, the credit card appears to be used as a read-only device.

Applicant respectfully submits that the Walker et al. neither discloses nor suggests the elements and limitations of claims **2, 4-15, 17, 18, 21, 22, 24, 25, 27-32, 34, 38, 41 and 42**. Because of this, Applicant respectfully submits that claims **2, 4-15, 17, 18, 21, 22, 24, 25, 27-32, 34, 38, 41 and 42** are distinguished from Walker et al., and that the rejections under **35 U.S.C. §§ 102(e) and 103(a)** of claims **2, 4-15, 17, 18, 21, 22, 24, 25, 27-32, 34, 38, 41 and 42** are not justified. Furthermore, it would appear that the Examiner has used improper hindsight reasoning in view of the teachings of the instant application to assert these claim rejections. Accordingly, Applicant respectfully traverses all of these rejections on the grounds that the Examiner has not established a prima facie basis for making the rejections. Applicant respectfully requests reconsideration and allowance of claims **2, 4-15, 17, 18, 21, 22, 24, 25, 27-32, 34, 38, 41 and 42** in view of the above argument.

Extension of Time and Payment of Fees Under 37 CFR § 1.17(a)(2)
Authorization to Charge Fee Deficiencies

Applicant hereby petitions for a Two-Month Extension of Time, pursuant to 37 C.F.R. §1.136, extending the deadline for response up to and including 23 July 2006, resulting in an associated fee of **\$225** under 37 C.F.R. § 1.17(a)(2). A Credit Card Payment Form in the amount of **\$225** is enclosed herewith for payment of the fee under 37 C.F.R. § 1.17(a)(2). The

Commissioner is authorized to charge any deficiencies or credit any overpayments – that cannot otherwise be made to the credit card -- to Deposit Account **04-1131**.

Summary and Conclusions

The claim rejections have been traversed. Applicant respectfully submits that no new matter has been added by this amendment. Applicant respectfully submits that the instant application is now in the proper form for Notice of Allowance, and respectfully requests a timely issuance thereof in this application.

Respectfully Submitted,

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